

### **REMARKS**

The following issues are outstanding in the pending application:

- Claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28 are rejected under 35 USC 103;
- Claims 10-12 are rejected under 35 USC 103;
- Claims 16 and 26 are rejected under 35 USC 103; and
- Claims 22-24 are rejected under 35 USC 103.

#### **Claim Amendments**

The claims have been amended in order to more clearly define the subject matter of the invention. Claims 1, 21 and 25 have been amended to recite “lateral side” portions rather than “side edges”. The tension of the film material is controlled and reduced while it is being moulded, allowing additional film material to penetrate between the positive and negative mould in amounts sufficient to form controlled lateral creases in the film material around the entire lower edge portion of the moulds. Claims 7 and 23 have been amended to conform the subject matter to the amendment in claim 1 and 21 respectively. Claims 29 and 30 are new. No new matter has been added.

#### **35 USC 103**

**Claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28** are rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 4,246,223 to Patterson in view of U.S. 2002/0079611 to Ellison et al. Applicant respectfully traverses this rejection.

Patterson discloses a method and apparatus for making compartment trays formed from coated paper milk carton stock in which the compartments are separated by dividers. Tray blanks are cut and are scored in order to control the formation of wrinkles when the blank is folded and formed in the single set of dies. The forming and wrinkling of the tray surface is controlled by the positions of the scored regions of the blank. The mating male and female dies form three compartments in the tray blank.

Ellison discloses a process and apparatus for preparing a molded article in which film is placed over a mold cavity and extending over the mold rim cavity. The film is held in place over the mold cavity by a frame that engages the film adjacent to the mold cavity rim. Molten plastic is poured over the film, forming a molded article in the shape of the mold cavity in which the film is an outer layer of the molded article. The film tension is controlled in order to minimize film thinning and wrinkling in the molded part.

*Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquiries enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143.

The instant claims require controlling and reducing the tension of the film allowing additional film material to penetrate between the positive and negative moulds in amounts sufficient to form lateral creases in the film material around the entire lateral side portion of

the mould. As shown below, at least these claim limitations have not been accounted for in the cited art, and no *prima facie* case for obviousness is made.

The limitation that lateral creases are formed in the film material around the *entire* lateral side portion of the moulds has not been accounted for in the prior art. Patterson discloses dies for forming multiple compartments in a paper tray in which the paper blanks are scored to cause wrinkles to form in the scored regions before placing the tray blank between a set of dies. The paper stock is scored in the bend regions adjacent the ridges and corners of the tray to relieve stresses occurring during the forming operation. During formation, the wrinkles are formed *only in the corners* of the three compartments of the tray, while the instant claims recite that the creases are formed around the entirety of the lateral side portions. Ellison also does not account for this claim limitation.

The Examiner argues that the term “lower edge portion” introduces ambiguity into the claims and does not find support in the specification or the drawings. Office Action dated July 24, 2008 (the “Action”), page 8. The Applicant herein amends the instant claims to recite “lateral side portion” which further clarifies the claims. Support for this amendment can be found at least at paragraph [0037] and in Figure 4 (elements labeled 20b-23b). The Examiner further argues that it is unclear from the claim which mould is actually being claimed. The Applicant points out the recitation of mould in the section of the claim the Examiner refers to specifies the specific area of the flexible film that forms lateral creases, the area of which is given relative to the moulds. This area is between the two lateral sides of the moulds, and the claims have been amended to recite “moulds”, as opposed to “mould” to clarify. Patterson and Ellison do not account for the limitation that the creases are formed around the entirety of the lateral side as the claims now clearly recite. The structure in Patterson that the Examiner relies on for this teaching, the lip of the tray, is not comprised on a lateral side of the moulds, rather, it is formed on the outside of the moulds. Further, the lip of Patterson’s tray only forms creases on the corner portions, not along the entirety of the lip.

Additionally, the limitation of reducing tension to a degree sufficient to allow lateral crease formation has not been accounted for in the prior art. The Examiner agrees that Patterson does not disclose the limitation; “[w]hat Patterson does not disclose is the reduction

of the tension in a controlled manner.” Action, page 2. Instead, the Examiner relies on Ellison to teach the reduction of film tension. Action, page 2, citing Ellison Figure 1, paragraphs [0013] and [0029]. Ellison paragraph [0013] teaches that the film tension is controlled and released during the mold closing step “so as to minimize film thinning and wrinkling in the molded part.” Ellison accounts only for reducing the amount of tension to a degree sufficient to stop film thinning. However, Ellison *still retains enough tension to minimize wrinkling*. Therefore, Ellison does not teach reducing the amount of tension to allow additional film material to penetrate between the positive and negative moulds in *amounts sufficient to form lateral creases* in the film material around the entire lateral side portion of the mould.

The Examiner argues that the “wherein” clause of the claims is not a limitation, but rather discloses the intended result of the process set. Action, page 9, citing MPEP § 2111.04. While the Applicant does not necessarily agree, the Applicant herein amends the claims such that the recitation is a positive limitation of the instant claims. The amended claims positively recite that the reduction in tension allows additional film material to penetrate the mould in amounts sufficient to form lateral creases in the film material. This limitation is not accounted for in either the Patterson or the Ellison reference.

In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of the claims and their meaning as the cited references do not include all elements of independent claims 1 and 19. As stated above, neither references teaches the formation of creases along the entirety of the lateral side, or the reduction of tension in amounts sufficient to form the creases. Applicant respectfully asserts that modifying the teaching of Patterson with the teaching of Ellison will not provide the method of independent claims 1 and 21 and the device of independent claim 25.

Further, one of skill in the art would not have combined Peterson with Ellison, as Ellison teaches away from the combination. MPEP §2141.02 VI. The film of Ellison is the outer layer of the molded article, with the inner layer formed from molten plastic that was poured over the film. Patterson [0011]. The outer layer provides the color for exterior

vehicle parts formed from the cooled molten plastic. Ellison [0001 and [0037]. Ellison further teaches, and one of skill in the art would recognize, that wrinkles in the exterior of such parts are to be avoided. Ellison [0013]. Peterson, however, teaches scoring paper and then applying pressure to said paper to create divided trays with wrinkles formed from the scoring. Patterson, col. 3, last paragraph. These two teachings would not be combined by one of skill in the art because one would avoid wrinkles in the product taught by Ellison, while corner wrinkles are an express teaching of Patterson. The court maintains that it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements.” *KSR*, 127 S. Ct. at 1741. No such reason has been given by the Examiner and no such reason exists, as Ellison specifically teaches against the invention of Patterson.

If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition non-obvious. Applicant respectfully submits that claims 3-9, 14, 15, 17-20, 27 and 28 depend at least in part from amended independent claims 1, 21 or 25 respectively. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28 under 35 U.S.C. 103(a) as having subject matter unpatentable over U.S. Pat. No. 4,246,223 to Patterson in view of U.S. 2002/0079611 to Ellison et al.

**Claims 10-12** have been rejected under 35 USC 103(a) as having subject matter unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Pat. No. 3,762,125 to Prena. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over Patterson and Ellison obviates the present rejection. The Prena reference adds no new teaching to the Patterson and Ellison references that would result in the inventive method of amended independent claim 1. Claims 10-12 depend at least in part on amended independent claim 1. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from claim 1, claims 10-12 are nonobvioius over these references. Accordingly,

Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 10-12 under 35 U.S.C. 103(a) as being unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Patent No. 3,762,125 to Prena.

**Claims 16 and 26** have been ejected under 35 USC 103(a) as having subject matter unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Pat. No. 4,124,421 to Fujii. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the Patterson and Ellison references obviates the present rejection. The Fujii reference adds no new teaching to these references that would result in the inventive method of amended independent claim 1 or 25. Claims 16 and 26 depend at least in part on amended independent claims 1 and 25 respectively. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from claims 1 and 25 respectively, claims 16 and 26 are nonobvioius over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 16 and 26 under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison et al. in view of U.S. Patent No. 4,124,421 to Fujii.

**Claims 22-24** have been rejected under 35 USC 103(a) as having subject matter unpatentable over Patterson and U.S. 2002/0079611 to Ellison et al. in view of U.S. Pat. No. 5,009,056 to Porteous. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over Patterson and Ellison obviates the present rejection. The Porteous reference adds no new teaching to the Patterson and Ellison references that would result in the inventive method of amended independents claim 21. Claims 22-24 depend at least in part on amended independent claim 21. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their

dependency from claim 21, claims 22-24 are nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 22-24 under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison in view of U.S. Patent No. 5,009,056 to Porteous.

### **CONCLUSION**

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no additional fee is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03195US0 from which the undersigned is authorized to draw.

Dated: September 19, 2008

Respectfully submitted,

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